

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-24 and 34-42 are currently pending. Claims 25-33 have been cancelled without prejudice or disclaimer; and Claims 1-17, 19, 20-22, 24, and 34-42 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1 and 17 were objected to as containing non-descriptive preambles; Claims 25-33 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; Claims 4-9, 14, 20-24, 31, and 40 were rejected under 35 U.S.C. § 112, second paragraph, regarding the use of the phrase “can be”; Claims 1, 2, 10, 17, 18, 25, 26, 34, and 35 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,148,979 to Yanagawa (hereinafter “the ‘979 patent”); and Claims 3-6, 8, 9, 11-13, 15, 16, 19-24, 27-30, 32, 33, 36-39, 41, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘979 patent in view of U.S. Patent No. 6,973,597 to Schroath et al. (hereinafter “the ‘597 patent”).

Applicant respectfully traverses the objection to Claims 1 and 17 as containing non-descriptive preambles. It is noted that MPEP 2011.02(II) states that a “preamble may provide context for claim construction, particularly, where...that preamble’s statement of intended use forms the basis for distinguishing the prior art in the patent’s prosecution history.” *Metabolite Labs., Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-1087 (Fed. Cir. 2004). However, it is respectfully submitted that a preamble is not required to establish the environment or objective of the claimed invention, as asserted by the Office Action.

Regarding the rejections of Claims 25-33, it is respectfully submitted that the rejection of those claims is rendered moot by the present cancellation of Claims 25-33.

Applicant respectfully traverses the rejections of Claims 4-9, 14, 20-24, and 40 under 35 U.S.C. § 112, second paragraph. Applicant notes that the Office Action asserts that it is unclear as to what happens in a situation where the abnormality cannot be eliminated by the user. Further, the Office Action asserts that the scope of “abnormality” is not clearly defined. However, Applicant respectfully submits that Claims 4-9, 14, 20-24, and 40 are merely broad in this regard and are not unclear. For example, with regard to Claim 4, one of ordinary skill in the art would clearly understand that the abnormality counter controller would up count when the type of the abnormality determined by the abnormality type determination part represents an abnormality that can be eliminated by the user of the electronic apparatus. Not reciting what the counter controller does when the abnormality is of a different type does not make the claim less clear, merely broad. Further, it is respectfully submitted that one of ordinary skill in the art would clearly understand the abnormality recited in Claim 1.

Amended Claim 1 is directed to an electronic apparatus, comprising: (1) an abnormality detector configured to detect an abnormality when the abnormality occurs; (2) an abnormality type determination part configured to determine a type of the abnormality detected by said abnormality detector; and (3) an abnormality notification part configured to automatically inform an external apparatus of the abnormality only when the type of the abnormality determined by said abnormality type determination part represents an abnormality that cannot be eliminated by a user of said electronic apparatus. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.¹

¹ See, e.g., page 51, line 7 to page 52, line 15; and page 79, lines 1-10 of Applicant’s specification.

Regarding the rejection of Claim 1 under 35 U.S.C. § 102(e), the '979 patent is directed to a printing system and method of dealing with problems in said system. The outstanding Office Action cites column 6, lines 54-63 and column 7, lines 18-24 of the '979 patent as disclosing an abnormality type determination part configured to determine a type of the abnormality detected by said abnormality detector, as recited in Claim 1. However, the cited sections of the '979 patent only disclose that, among the problems sensed by the sensors 105 to 109 of the printing apparatus 3, there are certain simple problems that the operator of the apparatus can readily deal with to effect recovery. Those sections are silent as to how the types of problems are determined. Further, the '979 patent merely discloses that a printer driver is notified of a detection by particular sensors 110 to 114, and that the printer driver causes information of the detection to be displayed on the host computer.² The '979 patent does not disclose an abnormality type determination part configured to determine a type of the abnormality detected by said abnormality detector.

Further, the Office Action asserts that column 7, lines 50-59 of the '979 patent discloses the "abnormality notification part" of Claim 1. That section of the '979 patent discloses that, in the event of a problem from which it is difficult for the operator to effect recovery, such as a problem sensed by any of the sensors 110 to 114, the printer driver is notified of problem detection by any of the sensors 110 to 114 and causes an Internet address (URL), which has been stored in the ROM, to be displayed on the display of the host computer. The '979 patent discloses that the operator observes the display, effects a connection to the Internet and queries the printer service depot computer about the nature of the problem.³ The '979 patent further discloses that the service depot computer judges that the relevant problem codes are 110, 111, and 112, and displays answers on the display of the host computer 1 via the network 5 to indicate the cause of the problem.

² See '979 patent, column 7, lines 50-56.

³ Id. at column 7, lines 57-59.

However, it is respectfully submitted that the '979 patent fails to disclose an abnormality notification part configured to automatically inform an external apparatus of the abnormality only when the type of the abnormality determined by said abnormality type determination part represents an abnormality that cannot be eliminated by a user of said electronic apparatus. Rather, the '979 patent discloses that an external apparatus is also notified of problems that are solvable by the customer.⁴ Further, the '979 patent discloses that a problem detected by any of the sensors 110 to 114, which cannot be solved by the operator, is displayed on the host computer 1 through a printer driver, and, then, the operator acquires the nature of the problem from the service depot through the network. Similarly, if it is possible for the customer to solve the problem himself without the assistance of a serviceman, the customer support computer is queried in regard to the nature of the problem.⁵ That is, the '979 patent discloses querying an external apparatus regarding an abnormality. The '979 patent does not disclose or suggest an abnormality notification part for automatically informing an external apparatus of an abnormality only when the type of the abnormality represents an abnormality that cannot be eliminated by an operator.

Accordingly, it is respectfully submitted that Claim 1 (and all associated dependent claims) patentably defines over the '979 patent.

Amended Claim 10 recites limitations analogous to the limitations recited in Claim 1. Further, Claim 10 has been amended in a manner analogous to the amendments to Claim 1. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 1, it is respectfully submitted that Claim 10 (and all associated dependent claims) patentably defines over the '979 patent.

Amended Claims 17 and 34 recite, in part, determining a type of the detected abnormality; and automatically informing an external apparatus of the abnormality only when

⁴ See '979 patent, column 7, lines 18-63; and column 11, lines 18-22.

⁵ Id. at column 11, lines 18-22.

the determined type of the abnormality represents an abnormality that cannot be eliminated by a user of the electronic apparatus. The changes to Claims 17 and 34 are supported by the originally filed specification and do not add new matter.⁶

As noted above, the '979 patent fails to disclose an "abnormality type determination part" and an "abnormality notification part," as defined in Claim 1. Thus, the '979 patent fails to disclose the methods of Claims 17 and 34, respectively. Accordingly, Applicant respectfully submits that Claims 17 and 34 patentably define over the '470 patent.

Regarding the rejection of dependent Claims 3-6, 8, 9, 11-13, 15, 16, 19-24, 36-39, 41, and 42, it is respectfully submitted that the '597 patent fails to remedy the deficiencies of the '979 patent, as discussed above. Accordingly, it is respectfully submitted that Claims 3-6, 8, 9, 11-13, 15, 16, 19-24, 36-39, 41, and 42 patentably define over any proper combination of the '979 and '597 patents.

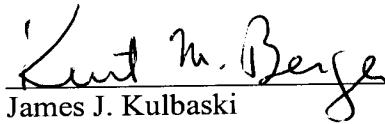
Thus, it is respectfully submitted that independent Claims 1, 10, 17, and 34 (and all associated dependent claims) patentably define over any proper combination of the '979 and '597 patents.

⁶ See, *e.g.*, page 51, line 7 to page 52, line 15; and page 79, lines 1-10 of Applicant's specification.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Kurt M. Berger", is written over a horizontal line.

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